

REMARKS

Claims 1-49 are pending in the present application. Claims 1-20, 22-24, 26, 31-32, 34-36 and 38-40 stand rejected under 35 U.S.C. §103(a) for obviousness over U.S. Patent No. 5,649,296 to MacLellan (the MacLellan patent) in view of U.S. Patent No. 5,493,437 to Lebby et al. (the Lebby patent) and U.S. Patent No. 5,245,329 to Gokcebay (the Gokcebay patent). Claims 21, 25, 33, 37 and 41 stand rejected under 35 U.S.C. §103(a) for obviousness over the MacLellan patent in view of the Lebby patent and Gokcebay patent and further in view of U.S. Patent No. 4,461,793 to Blok et al. (the Blok patent). Claims 27-29 stand rejected under 35 U.S.C. §102(b) for anticipation by U.S. Patent No. 5,462,374 to Kohno (the Kohno patent). Claim 30 stands rejected under 35 U.S.C. §103(a) for obviousness over the Kohno patent in view of the MacLellan patent. Claims 42-49 stand rejected under 35 U.S.C. §103(a) for obviousness over the Kohno patent in view of U.S. Patent No. 5,166,680 to Ganot (the Ganot patent).

17 Applicant respectfully traverses the rejections and urges allowance
18 of the present application.

19 Non-analogous art areas cannot properly be combined for an
20 obviousness rejection where the problems addressed by each are non-
21 analogous from one another. *In re Deminski*, 230 USPQ 313, 315 (Fed.
22 Cir. 1986.) A field of art is analogous *only* if one seeking the solution
23 in one art area would be likely to seek the solution by referring to the

1 other art. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 225
2 USPQ 634 (Fed. Cir. 1985).

3 The teachings of the Gokcebay patent have been improperly
4 combined with the teachings of the MacLellan patent and the Lebby
5 patent to establish the obviousness rejections. In particular, the
6 combination of non-analogous art areas is precluded by long standing
7 Federal Circuit precedent. Prior art references are only analogous if the
8 reference is in the field of Applicant's endeavor or the reference is
9 reasonably pertinent to the particular problem with which the inventor
10 was concerned. MPEP §2145(i) (citing *In re Oetiker*, 977 F.2d 1443, 24
11 USPQ2d 1443, 1445 (Fed. Cir. 1992)).

12 Referring to the rejection of independent claim 1, it is stated on
13 pages 5 and 6 of the Office Action that the Gokcebay patent teaches
14 the desire of an access control system that comprises a key having a
15 side with visibly perceptible information thereon and the dimension of
16 the side being less than the smallest dimensions of the upper and lower
17 surfaces for the purpose of carrying information relating to a personal
18 authenticating feature of the intended user of the key.

19 Referring to the above standards set forth by the Federal Circuit,
20 it is clear that the Gokcebay patent comprises art non-analogous to
21 Applicant's invention as well as the MacLellan and Lebby patents.
22 Independent claim 1 defines a remote intelligent communication device
23 comprising, in part, a card-thin housing and communication circuitry
24 within the housing configured to at least one of communicate and

1 receive electronic signals. The MacLellan patent further relates to
2 communication devices.

3 To the contrary, the Gokcebay patent relates to access control
4 systems with mechanical keys which store data. As stated in the
5 Abstract of the Gokcebay patent, the access control system includes a
6 series of keys having encoded data stored on the bottom edges of the
7 keys.

8 Independent claim 1 is clearly directly to communication devices
9 configured to at least one of communicate and receive electronic signals.
10 The Gokcebay patent is directed to access control systems, such as for
11 example, access for a door, gate, drawer, safe, safety deposit box,
12 computer terminal or other situation wherein high security is desirable
13 as stated in the Abstract of the Gokcebay patent. Clearly, the problems
14 in both art areas are different from one another. A person of skill in
15 remote communication device art or radio frequency identification
16 device (RFID) art would in no way think of looking at security or
17 access art to find meaningful teachings.

18 Accordingly, application of the Gokcebay patent in an obviousness
19 rejection of Applicant's claim 1 is inappropriate for at least this reason.
20 The rejection of independent claim 1 in view of the Gokcebay patent
21 is contrary to long-standing Federal Circuit precedent cited above.
22 Applicant respectfully requests the withdrawal of the obviousness
23 rejection for at least this reason.

1 The utilization of the Gokcebay patent in the subject obviousness
2 rejection of Applicant's claims is also improper for lack of suggestion
3 or teaching to combine the references. Referring to MPEP §2146(j)(3),
4 there must be some suggestion or motivation, either in the references
5 themselves or in the knowledge generally available to one of ordinary
6 skill in the art, to modify or combine reference teachings. The mere
7 fact that references *can* be combined or modified does not render the
8 resultant combination obvious *unless the prior art also suggests the*
9 *desirability of the combination.* MPEP §2143.01 citing *In re Mills*, 916
10 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

11 Obviousness cannot be established by a combination of references
12 unless there is some motivation in the art to support the combination.
13 (*See ACH Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577,
14 221 USPQ 929, 933 (Fed. Cir. 1984) ("Obviousness cannot be established
15 by combining the teachings of the prior art to produce the claimed
16 invention, absent some teaching, suggestion or incentive supporting the
17 combination.")). The motivation for forming the combination must be
18 something other than hindsight reconstruction based on using Applicant's
19 invention as a road map for such a combination. *See, e.g., Interconnect*
20 *Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re*
21 *Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight
22 reconstruction is an improper basis for rejection of a claim).

23 Evidence of a suggestion to combine may flow from the prior art
24 references themselves, from the knowledge of one skilled in the art, or

1 from the nature of the problem to be solved. However, this range of
2 sources does not diminish the requirement for actual evidence. Further,
3 the showing *must be clear and particular*. See *In re Dembiczak*,
4 No. 98-1498 (Fed. Cir. 4/28/99).

5 On page 6 of the Office Action, features of the respective
6 MacLellan, Lebby and Gokcebay patents are recited. In fact, *only*
7 *features* of the references which purportedly correspond to limitations of
8 Applicant's claims are discussed. The Office Action cites no teaching,
9 suggestion or motivation to combine the teachings of the Gokcebay
10 patent with the other references. Evidence of the suggestion to combine
11 the references *must be clear and particular*. The record is entirely devoid
12 of any suggestion to combine the references, let alone any clear or
13 particular suggestion to combine the references in support of the
14 obviousness rejection of claim 1. Without any such teaching or
15 suggestion, the rejection of claim 1 is merely hindsight reconstruction
16 proscribed by the Federal Circuit. Independent claim 1 is in condition
17 for allowance for this additional reason.

18 Further, the Office Action cites a total of some three references
19 against Applicant's claim 1. The fact that the so many references were
20 combined in an attempt to show that Applicant's claimed invention is
21 "obvious" illustrates exactly why the invention is *not* obvious. There is
22 simply nothing like, or suggestive, of Applicant's claim 1 invention in the
23 prior art. Small pieces of the claimed invention have been allegedly
24 located scattered amongst a combination three references. *A person of*

1 *ordinary skill in the art would not combine the cited three teachings.* The
2 large number of cited references makes the rejection of claim 1 tenuous
3 in the extreme. Applicant respectfully requests allowance of claim 1 for
4 the above numerous reasons.

5 Claims 2-5 depend from independent claim 1 and therefore are in
6 condition for allowance for the reasons discussed above with respect to
7 claim 1 as well as for their own respective features which are neither
8 shown nor suggested by the cited art.

9 Referring to the rejection of independent claim 6, the Gokcebay
10 patent comprises non-analogous art to Applicant's invention. Accordingly,
11 such is not properly combinable to support an obviousness rejection of
12 independent claim 6. Applicant requests withdrawal of the obviousness
13 rejection for this reason alone.

14 Further, there is absolutely no motivation or suggestion to combine
15 the references in the manner provided in the rejection of claim 6. The
16 obviousness rejection of independent claim 6 is improper for this
17 additional reason. Applicant respectfully requests withdrawal of the
18 obviousness rejection. Applicant requests allowance of claim 6.

19 Claims 7-12 depend from independent claim 6 and therefore are
20 in condition for allowance for the reasons discussed above with respect
21 to claim 6 as well as for their own respective features which are neither
22 shown nor suggested by the cited art.

23 The Gokcebay patent comprises non-analogous art to Applicant's
24 invention. Accordingly, such is not properly combinable to support an

1 obviousness rejection of independent claim 13. Applicant requests
2 withdrawal of the obviousness rejection of claim 13 for this reason
3 alone.

4 Further, there is no motivation or suggestion to combine the
5 references in the manner provided in the rejection of claim 13. The
6 obviousness rejection of independent claim 13 is improper for this
7 additional reason. Applicant respectfully requests withdrawal of the
8 obviousness rejection. Applicant requests allowance of claim 13.

9 Claims 14-18 depend from independent claim 13 and therefore are
10 in condition for allowance for the reasons discussed above with respect
11 to claim 13 as well as for their own respective features which are
12 neither shown nor suggested by the cited art.

13 Claim 19 stands rejected for obviousness in view of the Gokcebay
14 patent. The Gokcebay patent comprises non-analogous art to Applicant's
15 invention and is not properly combinable to support an obviousness
16 rejection. Applicant requests withdrawal of the obviousness rejection of
17 claim 19 for this reason alone.

18 There is no motivation or suggestion to combine the references in
19 the manner provided in the rejection of claim 19. The obviousness
20 rejection of independent claim 19 is improper for this additional reason.
21 Applicant requests allowance of claim 19.

22 Claims 20-22 depend from independent claim 19 and therefore are
23 in condition for allowance for the reasons discussed above with respect

1 to claim 19 as well as for their own respective features which are
2 neither shown nor suggested by the cited art.

3 Claim 23 stands rejected for obviousness in view of the Gokcebay
4 patent. The Gokcebay patent comprises non-analogous art to Applicant's
5 invention and is not properly combinable to support an obviousness
6 rejection. Further, there is no motivation or suggestion to combine the
7 references in the manner provided in the rejection of claim 23. The
8 obviousness rejection of independent claim 23 is improper for these
9 reasons. Applicant requests allowance of claim 23.

10 Claims 24-26 depend from independent claim 23 and therefore are
11 in condition for allowance for the reasons discussed above with respect
12 to claim 23 as well as for their own respective features which are
13 neither shown nor suggested by the cited art.

14 Referring to the rejection of claim 27 under 35 U.S.C. §102(b),
15 the PTO and Federal Circuit provide that §102 anticipation requires that
16 *each and every element* of the claimed invention be disclosed in a single
17 prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed.
18 Cir. 1990). The corollary of this rule is that the absence from a
19 cited §102 reference of *any* claimed element negates the anticipation.
20 *Kloster Speedsteel AB, et al. v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81
21 (Fed. Cir. 1986).

22 Independent claim 27 defines a method of forming a card
23 comprising, in part, providing a card including an upper surface, a lower
24

surface and a plurality of sides, the sides individually having a dimension less than the smallest dimensions of the upper and lower surfaces.

Referring to the Kohno patent, a card having reference numeral 1 and a print head having reference numeral 4 are disclosed in Fig. 1 and Fig. 4. The Kohno patent as clearly illustrated in Fig. 1 and Fig. 4 discloses moving either an upper surface or a lower surface of the card and the print head relative to one another. The print head is disclosed as printing upon one of the upper and lower surface of the card. The Kohno patent fails to teach or suggest printing visibly perceptible information on at least one side of the card as claimed. Claim 27 is allowable for at least this reason.

Further, Applicant specifically defines sides individually having a dimension less than the smallest dimensions of the upper and lower surfaces in claim 27. Such is not shown nor suggested in the prior art. The surface printed upon by print head 4 does not have a dimension less than the disclosed sides of the card 1 in the Kohno patent. Accordingly, positively cited limitations within claim 27 have been utterly ignored in formulating the anticipation rejection of independent claim 27. In view of the above authority, the rejection of claim 27 is improper for at least this reason. Applicant respectfully requests withdrawal of the anticipation rejection.

In addition, the prior art of record including the Kohno patent fails to suggest provision of the method of forming a card as defined

1 in independent claim 27. Independent claim 27 is in condition for
2 allowance.

3 The Office Action, at page 3, states the Kohno patent discloses
4 cards individually having a side with a dimension less than the smallest
5 dimensions of the upper and lower surfaces. However, there is no
6 teaching or suggestion in the Kohno patent to encode visibly perceptible
7 information on the side of the card as defined in claim 27. Claim 27
8 is patentable over the Kohno patent.

9 Claims 28-30 depend from independent claim 27 and therefore are
10 in condition for allowance for the reasons discussed above with respect
11 to claim 27 as well as for their own respective features which are
12 neither shown nor suggested by the cited art.

13 Claim 31 stands rejected for obviousness in view of the Gokcebay
14 patent. The Gokcebay patent comprises non-analogous art to Applicant's
15 invention and is not properly combinable to support an obviousness
16 rejection. Applicant requests withdrawal of the obviousness rejection of
17 claim 31 for this reason alone.

18 There is no motivation or suggestion to combine the references in
19 the manner provided in the rejection of claim 31. The obviousness
20 rejection of independent claim 31 is improper for this additional reason.
21 Applicant requests allowance of claim 31.

22 Claims 32-33 depend from independent claim 31 and therefore are
23 in condition for allowance for the reasons discussed above with respect

1 to claim 31 as well as for their own respective features which are
2 neither shown nor suggested by the cited art.

3 Claim 34 stands rejected for obviousness in view of the Gokcebay
4 patent. The Gokcebay patent comprises non-analogous art to Applicant's
5 invention and is not properly combinable to support an obviousness
6 rejection. Further, there is no motivation or suggestion to combine the
7 references in the manner provided in the rejection of claim 34. The
8 obviousness rejection of independent claim 34 is improper for these
9 reasons. Applicant requests allowance of claim 34.

10 Claims 35-38 depend from independent claim 34 and therefore are
11 in condition for allowance for the reasons discussed above with respect
12 to claim 34 as well as for their own respective features which are
13 neither shown nor suggested by the cited art.

14 Applicant has amended claim 39 to define the solid housing having
15 a housing thickness with a dimension less than smallest dimensions of
16 the upper and lower surfaces. Claim 39 is patentable over the prior
17 art.

18 Claim 39 stands rejected for obviousness in view of the Gokcebay
19 patent. The Gokcebay patent comprises non-analogous art to Applicant's
20 invention and is not properly combinable to support an obviousness
21 rejection. Further, there is no motivation or suggestion to combine the
22 references in the manner provided in the rejection of claim 39. The
23 obviousness rejection of independent claim 39 is improper. Applicant
24 requests allowance of claim 39 for these reasons.

1 Claims 40-41 depend from independent claim 39 and therefore are
2 in condition for allowance for the reasons discussed above with respect
3 to claim 39 as well as for their own respective features which are
4 neither shown nor suggested by the cited art.

5 Referring to the obviousness rejection of claim 42, the Ganot
6 patent also comprises non-analogous art to Applicant's invention. The
7 Ganot patent relates to a portable parking meter device and method of
8 operating the same. Such is clearly non-analogous to remote intelligent
9 communication devices or radio frequency identification devices (RFID).
10 The rejection of independent claim 42 is improper for at least this
11 reason.

12 Additionally, there is no teaching, motivation or suggestion to
13 combine the references in support of the obviousness rejection of
14 claim 42. The obviousness rejection of claim 42 is improper for this
15 reason alone.

16 Even if the teachings of the references are combined as set forth
17 in the Office Action, such combined teachings of the references do not
18 support an obviousness rejection of claim 42. An obviousness rejection
19 requires consideration of all the elements of the claimed invention.
20 Further, all such elements must be shown to be suggested by the prior
21 art when making a rejection based upon obviousness under 35
22 U.S.C. §103(a). *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.
23 Cir. 1987). The test for obviousness is what the combined teaching of
24 the references would have suggested to those of ordinary skill in the

1 art. *In re Keller*, 642 F.2d 413, 208 USPQ 871, 881 (CCPA 1981),
2 MPEP §2145(c).

3 The Kohno patent fails to teach or suggest encoding indicia upon
4 a *side surface* as claimed. Further, none of the cited prior art
5 references disclose the encoding of identification indicia as claimed.
6 Applicant has cited limitations in claim 42 not disclosed or suggested in
7 the prior art references. Accordingly, even if the prior art references
8 are improperly combined, such combination does not render obvious
9 Applicant's claim 42. Claim 42 is in condition for allowance for the
10 above numerous reasons.

11 Applicant notes the Office Action on pages 2-3 includes numerous
12 responses to Applicant's previously asserted points in the Amendment
13 dated May 14, 1999. Two of the previously asserted points in the
14 Amendment asserted that the Ganot patent comprises non-analogous
15 subject matter and there is no motivation, teaching or suggestion to
16 support the combination of references made in the obviousness
17 rejections. The numerous responses in the Office Action dated
18 August 3, 1999 fail to address these points. Applicant respectfully
19 requests comment on these points in the event such current obviousness
20 rejections of Applicant's claims are maintained.

21 Claims 43-45 depend from independent claim 42 and therefore are
22 in condition for allowance for the reasons discussed above with respect
23 to claim 42 as well as for their own respective features which are
24 neither shown nor suggested by the cited art.

1 Referring to the obviousness rejection of claim 46, the Ganot
2 patent comprises non-analogous art to Applicant's invention and as such
3 is not a proper reference to support the obviousness rejection. The
4 rejection of independent claim 46 is improper for at least this reason.

5 Further, there is no teaching, motivation or suggestion to combine
6 the references in support of the obviousness rejection of claim 46. The
7 obviousness rejection of claim 46 is improper for this additional reason.

8 In addition, none of the cited prior art references disclose the
9 encoding of identification indicia on a *side surface* as claimed. Applicant
10 has cited limitations in claim 46 not disclosed or suggested in the prior
11 art references. Accordingly, even if the prior art references are
12 improperly combined, such combination does not render obvious
13 Applicant's claim 46. Claim 46 is in condition for allowance for the
14 above numerous reasons.

15 Claims 47-49 depend from independent claim 46 and therefore are
16 in condition for allowance for the reasons discussed above with respect
17 to claim 46 as well as for their own respective features which are
18 neither shown nor suggested by the cited art.

19 Applicant respectfully requests allowance of all pending claims.

20 The Examiner is requested to phone the undersigned if the
21 Examiner believes such would facilitate prosecution of the present
22
23
24

1 application. The undersigned is available for telephone consultation at
2 any time during normal business hours (Pacific Time Zone).

3

4 Respectfully submitted,

5 Dated: 11/3/99

6 By:

7 
James D. Shaurette
Reg. No. 39,833

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24